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Attorney Docket No. VX042585

REMARKS

Claims 1-4, 6, 9, 11 and 13-14 are pending. Claims 5, 7, 8, 10, and 12 are canceled. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

The examiner has objected to the drawings as not showing each and every feature of the invention specified in the claims. Insofar as the objection can be applied to the claims as amended, the objection is respectfully traversed. The objected-to-limitation in claim 1 is illustrated in FIG. 5, elements S7, S8 and FIG. 6, elements S11, S12; the objected-to-limitation in claim 3 is illustrated in FIG. 1, element 10 and FIG. 8 elements S22, S23 and S24; and the objected-to limitation in claim 5 is illustrated in FIG. 6, elements S13, S14. Moreover, the claims do not need to be in *ipsis verbis* in the specification or the drawings. In view of all of the above reasons, the examiner is respectfully requested to reconsider and withdraw the objection to the drawings.

Claims 1-13 were rejected under 35 USC 112, first paragraph as not being enabled. However, the office action states that various limitations in the claims are unclear. Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following.

The office action has improperly commingled objections with the 35 USC 112, first paragraph rejection. The rejection of claim 1 lines 4-5 appears to be better stated as an objection because the examiner thinks the claims are unclear. Similarly, the rejection of claims 2, 3, and 4 would be better stated as an objection because the examiner thinks the claims are unclear. Claim 4 has not been amended to distinguish between "a user" and "the user information" because "a user" and "the user information" are separate, and the antecedent basis of "a user" and "the user

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information” thus is proper. Furthermore, because the examiner argues that the antecedent basis is not proper, the rejection of claim 4 should have been expressed instead as an objection. With regard to the rejection of claim 5 for lack of support, the examiner’s attention is drawn for example to FIG. 6, elements S13, S14, and page 7, lines 16-21.

Claims 1-5, 8, 10 and 12 were rejected under 35 USC 102(e) as being unpatentable over U.S. Patent Publication No. 2002/0123840, Obata et al. (“Obata”) in view of U.S. Patent Publication No. 2004/0204032, Hisano et al. (“Hisano”). Claims 6, 7, 9, 11 and 13 were rejected under 35 USC 103(a) as being unpatentable over Obata in view of Hisano, further in view of U.S. Patent No. 4,651,157, Gray et al. (“Gray”). Independent claim 1 has been amended. Support for the amendment is located in the specification as filed, for example, page 4, lines 20-23; page 18, line 17 to page 19, line 2; and page 22, line 1 to page 23, line 3.

Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of amendment.

As described in the application, the invention recognizes the problems caused by charging for use of a communication channel, where the communications are associated with a terminal that can be switched between traveling machines (and hence between entities that should be charged for the communications). (E.g., specification p. 1, line 18 – p. 2, line 3; p. 2 lines 18 – 23.)

Independent claim 1 recites, for example, “a terminal provided on a construction machine; and a server connected to the terminal through a communication channel.” The server is “configured to facilitate managing construction machine information unique to the construction machine, managing user information unique to the terminal, associating a unique

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identifier with the terminal, setting a start and an end of a communication period and associating the communication period with the terminal, acquiring the identifier of the terminal from the user information managed by the server, and notifying the user that the communication period is ending when the communication period ends. ”

In operation, by managing the communication period associated with a terminal based on the terminal identifier, charges for communications during the communication period can be appropriately billed, the (E.g., specification page 5, lines 7 – 13.)

On the other hand, without conceding that Obata discloses any feature of the present invention, Obata is directed to timely reporting on vehicle positions to a control center (Abstract). According to Obata, the vehicle position can be reported at fixed intervals. “If the specified time has passed, the current position information is reported (S400)... [t]his position information may include supplemental information such as vehicle number, the date and time of the position measurement, and vehicle speed and the like.” (Paragraph [0028].)

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

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The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The examiner argues that Obata discloses each of the recited elements of claim 1, but admits that Obata does not teach or suggest the association of the communications with a particular user during the communication period. Several examples are discussed below of recited elements which are neither taught nor suggested by the references.

Neither Obata nor Hisano teach or suggest using "unique" identifier associated with the terminal. Obata does not use the terminal identifier. Hisano, on the other hand, temporarily assigns an available ID for a single communication (separate from the serial number of the communication terminal), and the ID is released for re-use when the communication is over (paragraph [0038], claim 4 line 19-23). Hence, Hisano's temporary ID is not associated with the terminal.

Furthermore, neither Hisano nor Obata teach or suggest that a communication period has a start and an end, in combination with other recited elements. By using the communication period which has an actual start and end, the user can be notified when the communication period is ending. To the contrary, Hisano's allocated time, cited by the examiner as being the

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communication period, is simply an estimated duration, e.g., 60 seconds. Hisano's user is not notified when the estimated communication duration ends, because the communication duration is merely an estimate.

For this additional reason, Hisano fails to teach or suggest the communication period for which a start and end is set. Hisano's allocated time is apparently merely "expected" and the single communication apparently can exceed the allocated time and still be associated with Hisano's identifier (paragraph [0061]).

Hence, Hisano and Obata, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

New claim 14 is added, and is deemed patentable for reasons including those provided above. Support for new claim 14 is located in the specification as filed, for example FIG. 1 and FIG. 8.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of

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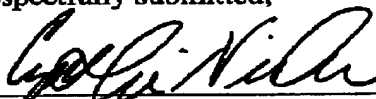
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simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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